

REMARKS

Initially, applicants note that a request (petition) to withdraw the present (Final) Action was filed February 15, 2008, and is now being decided by the Technology Center SPRE. The instant response is being filed since the filing of the petition does not stay the period for response. The instant response is not a request to withdraw the petition. Consideration of the response should be stayed pending a decision on the petition.

Referring to the Action, the Office has maintained the rejection of claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al., U.S. Patent No. 6,150,076 ("Yamamoto"), and the rejection of claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto in view of Sales, U.S. Patent No. 5,169,888 ("Sales"), that were made in the Office Action of May 30, 2007.

In the response filed August 30, 2007, to the Office Action of May 30, 2007, applicants amended claim 6 to recite the process of the invention of the present application in terms of a process for producing an aqueous resin dispersion composition "consisting essentially of" an acid-modified chlorinated polyolefin, basic substance and water, and to recite the final step of the process as

the removal of the ethereal solvent "to obtain the aqueous resin dispersion".

Applicants argued that Yamamoto, alone or combined with Sales, does not support the 35 U.S.C. § 103(a) rejections because, first, it is at best unclear from the disclosure in Col. 7 of Yamamoto that "the above-described components of the photosensitive resin composition are dissolved in any order and mixed in an appropriate solvent or component (D)" (lines 26-29), which indicates that all of the components of the photosensitive resin composition are added to a solvent or solvents at the same time, can be reasonably interpreted as including a process as recited in claim 6 where an acid-modified chlorinated polyolefin is dissolved in an ethereal solvent and is then added to water.

Applicants argued, second, that Yamamoto discloses that the solvent (i.e., all solvents including water) is removed in the process disclosed therein and that nowhere is it disclosed or suggested that an ethereal solvent alone is or can be removed. Applicants noted that claim 6, prior to the amendments made in the response and subsequent thereto, cannot be reasonably interpreted as reading on the removal of both an ethereal solvent and water.

Applicants further argued that, notwithstanding the foregoing arguments, the "consisting essentially of" terminology added to

claim 6 excludes non-recited components such as the hydrophilic polymer (B) of the composition of Yamamoto that would be expected to affect the basic characteristics of the aqueous resin dispersion composition. Applicants also noted that claim 6 was also amended to specifically recite that the ethereal solvent is removed to obtain the aqueous resin dispersion.

Finally, applicants explained that the showing of the criticality of the process sequence recited in claims 6-11 of the present application that was made in the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA submitted with the response of May 22, 2006, is sufficient to demonstrate the unobviousness of the process of the present invention. Applicants specifically requested consideration of this showing.

In response to the arguments in the response filed August 30, 2007, the Office has taken the position that the "consisting essentially of" terminology does not require exclusion of the hydrophilic polymer (B) disclosed in Yamamoto because applicants have failed to provide proof that the hydrophilic polymer (B) of Yamamoto would affect the process as claimed.

Regarding the step of "removing the ethereal solvent to obtain the aqueous resin dispersion", the Office has taken the position that the claim (claim 6) does not require all ethereal solvent to

be removed and that the aqueous dispersion of Yamamoto would remain as an aqueous dispersion until all the solvent has evaporated.

The Office failed to respond to the argument that the showing in the 132 Declaration of Tatsuo TSUNEKA is sufficient to demonstrate the unobviousness of the process of the present invention.

Applicants submit that the position of the Office regarding the hydrophilic polymer (B) not being excluded from the process of the invention is incorrect. The "consisting essentially of" terminology added to claim 6 operates to limit the composition of the aqueous resin dispersion.

The position of the Office that claim 6 reads on the aqueous dispersion of Yamamoto before all the solvent has evaporated is improper. First, a proper interpretation of claim 6 is that the claim requires that all of the ethereal solvent be removed. Second, Yamamoto does not disclose isolating an aqueous resin dispersion containing an ethereal solvent and water. A claim cannot read on a composition that does not exist in the prior art.

Finally, the Office's failure to consider the comparative data is improper. In maintaining a rejection, the Office is required to answer all material traversed. MPEP §707.07(f) provides: "[w]here the applicant traverses any rejection, the examiner

should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Furthermore, in holding applicants' arguments to be non-persuasive, the Office must "address all arguments which have not already been responded to in the statement of rejection." The Office is not permitted to answer only selected arguments in maintaining rejections of the claims. In the present action, the Office has not addressed arguments relating to comparative data in the statement of rejection or in its response to arguments.

As noted above, a petition requesting withdrawal of the present Action was filed January 15, 2008. This petition is based on the Office's failure in the present Action to address arguments relating to the comparative data of the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA submitted with the response of May 22, 2006.

Removal of the rejections of the claims is believed to be in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated November 16, 2007, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone

interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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